

DOCKET NO.: 262367US41X PCT/scm

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 2834

Christophe RIPOLL

SERIAL NO: 10/518,435

EXAMINER: ROSENAU, D. J.

FILED: July 1, 2005

FOR: METHOD FOR ELECTRONIC ACTIVATION OF A DRIVER DEVICE OF A
PIEZOELECTRIC ACTUATOR

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.


This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Philippe J.C. Signore, Ph.D.
Registration No. 43,922

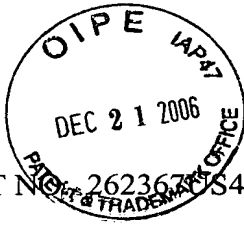
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IN RE APPLICATION OF :
CHRISTOPHE RIPOLL : EXAMINER: ROSENAU, D. J.
SERIAL NO: 10/518,435 :
FILED: JULY 1, 2005 : GROUP ART UNIT: 2834
FOR: METHOD FOR ELECTRONIC :
ACTIVATION OF A DRIVER DEVICE OF
A PIEZOELECTRIC ACTUATOR

REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS

Applicants submit that the Official Action of June 27, 2006 and the Advisory Action of November 2, 2006 have failed to provide a *prima facie* case of obviousness with respect to Claims 14, 16, and 17 (and Claim 15 which depends from Claim 14).

Pending Claims 14-17 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Series Resonant Converter with Sandwich-Type Piezoelectric Ceramic Transducers*, 6th European Conference on Power Electronics and Applications, pages 591-594, by P. Fabijanski (hereinafter Fabijanski) in view of Rueger et al. (U.S. Patent No. 7,019,436), and further in view of Yamada et al. (U.S. Patent No. 5,036,263, hereinafter Yamada).

To establish a *prima facie* case of obviousness, MPEP §2143 requires that three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim elements. The outstanding Office Action is deficient with respect to the third requirement.

FAILURE TO TEACH OR SUGGEST EVERY ELEMENT OF CLAIMS 14, 16,
AND 17

The Official Action mailed June 27, 2006 sets forth the subjective conclusion that Claims 14, 16, and 17 are obvious because the device of Fabijanski is capable of performing the timing sequence as described in Claims 14, 16, and 17. It is not understood how this conclusion can be reached in light of the admission that “Fabijanski ***does not*** discuss the specifics of the timing of opening and closing the switches of the apparatus of Fig. 6.”¹ In this regard, it is noted that substitution of an improper subjective conclusion as to knowledge in the art for concrete evidence of such knowledge relative to a core factual finding required for a determination of patentability is clearly improper.²

Furthermore, the Advisory Action mailed November 2, 2006 states “Applicant argues that Fabijanski does not disclose the timing of switches as specified in claims 14, 16, and 17. ***While this is true***, these claims only require that ‘the bridges circuits are configured to be activated...’ The timing sequences provided in these claims do not define any structural elements, and as the bridge circuit of Fabijanski is the same as that of the present application, the bridge circuit of Fabijanski is configured to provide the same timing of the switches.”³

¹ Office Action, pages 10, 11, and 12, emphasis added.

² See In re Zurko, 59 USPQ2d 1693, 1697-98 (Fed. Cir. 2001)

³ Advisory Action, November 2, 2006, page 3, emphasis added.

As the Advisory Action concedes that Fabijanski does not disclose the subject matter of Claims 14, 16, and 17, it is incomprehensible as to how the PTO can conclude that the bridge circuit of Fabijanski is configured to be activated as recited in Claims 14, 16, and 17.

FUNCTIONAL LIMITATIONS MUST BE GIVEN PATENTABLE WEIGHT

The outstanding Office Action and Advisory Action err by not giving the functional limitations of Claims 14, 16, and 17 proper consideration. In this respect, the PTO has not instructed examiners to ignore functional claim definitions. To the contrary, and consistent with controlling precedent, MPEP §2173.05(g) instructs examiners that “[a] functional limitation *must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used*” (emphasis added). In addition, note, for example, *In re Angstadt*, 190 USPQ 214, 217 (CCPA 1976) further requiring that functional limitations must properly be considered.

REJECTION OF CLAIMS 8, 10, AND 12 ARE TRAVERSED

Claim 8 recites, *inter alia*, “a current flowing in the load is a periodic signal of a resonance frequency such that a chopping frequency of the signal is smaller than twice the resonance frequency.”

Claim 10 recites, *inter alia*, “a current flowing in the load is a periodic signal whose phase is advanced relative to the voltage across the terminals of the load, and resonance frequency of the current is such that a chopping frequency of the signal lies between half and twice the resonance frequency.”

Claim 12 recites, *inter alia*, “a current flowing in the load is a periodic signal whose phase is retarded relative to the voltage across the terminals of the load, and resonance frequency of the current is such that a chopping frequency of the signal is greater than half the resonance frequency.”

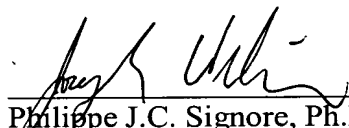
The rejection of Claims 8, 10, and 12 is traversed because Fabijanski, Rueger, and Yamada, taken alone or in proper combination, do not disclose or suggest at least the above-noted elements of Claims 8, 10, and 12.

CONCLUSION

Based on the clear deficiencies in the above-noted rejection, Applicants respectfully request that prosecution be re-opened.

Respectfully submitted,

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